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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,598	11/27/2001	Kristen L. Bhatti	10017080-1	8694

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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Fort Collins, CO 80527-2400

EXAMINER

NGUYEN, HOAI AN D

ART UNIT	PAPER NUMBER
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2858

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,598

Applicant(s)

BHATTI, KRISTEN L.

Examiner

Hoai-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-23 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori in view of Housel et al.

Mori teaches a print system and printer comprising:

- A job retention system (FIG. 3, printer controller 31) configured to store print-ready information corresponding to a print task (Column 3, lines 2-5 and 19-20) and to receive an input corresponding to a selected portion of the print-ready information, the print-ready information being configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device (Column 3, lines 10-43), with regard to claims 1, 4-7, 10 and 31.
- A printing device (FIG. 3, printer 10) includes a user interface, wherein the user interface is a graphical user interface (FIG.3, LCD 18), with regard to claims 7, 8, 12, 13, 30 and 31.

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- A printing device (FIG. 3, printer 10) having a memory (FIG. 3, RAM 13), the print-ready information being stored in the memory of the printing device (Column 3, lines 19-21), with regard to claims 2, 3, 11 and 27.
- Printing the selected portion of the information in the print-ready format using the printing device (Column 3, lines 26-27), with regard to claims 2.
- The job retention system (FIG. 3, printer controller 31) resides in the printing device, with regard to claim 11.
- A workstation (FIG. 1, computer 20) communicatively coupled to the printing device (FIG. 1, printer 10), the workstation having a driver, the driver being configured to convert information into the print-ready information and provide the print-ready information to the printing device, the driver being further configured to provide a graphical user interface (Column 3, lines 1-9 and 56-59), with regard to claims 14 and 15.
- Means (FIG. 1, RAM 13) for storing the information in the print-ready format (Column 3, lines 30-36), with regard to claim 16.
- The means for storing the information in the print-ready format is a disk drive (Column 3, lines 37-39), with regard to claim 17.
- The disk drive is a component of the printing device (Column 3, lines 30-39), with regard to claim 18.
- The means (FIG. 1, printer driver 42) for configuring the information is associated with a driver, the driver being configured to receive information in a

non-print-ready format and convert the information to the print-ready format (Column 3, lines 1-9), with regard to claims 9, 19 and 20.

- The selected portion of the print-ready information defines a page of the print task (Column 3, lines 30-32), with regard to claim 21.
- The selected portion of the print-ready information defines a range of pages of the print task (Column 3, lines 39-43), with regard to claim 22.
- Storing a collection of information in the print-ready format corresponding to a plurality of print tasks in the memory (Column 5, lines 17-64), with regard to claim 23.

However, Mori does not specifically teach the followings:

- The job retention system being further configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information, and the selected portion and the non-selected portion of the print-ready information correspond to a single print task.
- A user interface being configured to enable a user to select at least a portion of the print task.

Meanwhile, Housel et al. teaches a printing system comprising:

- The printing system 26 (FIG.1) being further configured to enable the selected portion of the print task to be printed without printing a non-selected portion of the print task, and the selected portion and the non-selected portion of the print-ready information correspond to a single print task (Paragraphs 0035-0037 and 59-61), with regard to claims 1, 4-7, 10, 29, 31 and 32.

- A user interfaces (FIG.1, user interfaces 13) being configured to enable a user to select at least the portion of the print task (Paragraphs 0092 –0097), with regard to claims 9, 12, 15 and 28.

With regard to claims 1, 4-7, 10, 29, 31 and 32, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Mori to permit the user to print only a **selected portion of a print task** taught by Housel et al., since Housel et al. teaches that this structure enables the users to easily designate their desired print jobs when inputting their request commands at the printer.

With regard to claims 9, 12, 15 and 28, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Mori to incorporate the teaching of the usage of a graphical user interface since Housel et al. teaches that such an interface is beneficial for permitting a user to check the status of a the print job or jobs or to determine how the print jobs are set up.

Response to Arguments

3. In response to applicant's argument about independent claim 1 on pages 9-11 that Mori fails to suggest or teach that “storing information corresponding to a print task in memory in a print-ready format, such that information in the print-ready format can be printed by a printing device without being processed by a driver”, the examiner disagrees. As disclosed in column 2, lines 1-5, Narita teaches “As shown in FIG. 2, the computer 20 is provided with: several application programs 41 for creating print data; a printer driver 42 for converting the print data to a format supported by the printer 10 and for transmitting the converted data to the printer 10”.

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Print data meant by Mori corresponds to “information corresponding to a print task” as claimed, and the converted data meant by Mori corresponds to “information in the print-ready format” as claimed. In addition, as disclosed in column 2, lines 14-21, Narita teaches “As shown in FIG. 3, ... ; a RAM 13 including various buffers for temporarily storing print data transmitted from the computer 20 and storing a printer job management table T2...”; that is, RAM 13 is the memory location in the printer 10 to store *the print data transmitted from the computer 20*, which is *the converted data* corresponding to “information in the print-ready format” as claimed.

Furthermore, as shown in FIG. 2, the printer driver 42 is not located in the printer 10; instead it is located in the computer 20. As a result, this particular disclosure in Mori meets limitations as claimed in the mentioned independent claim 1 right above.

In the last paragraph on page 11, the applicant agreed that Housel et al. teaches a printing system that permits a user to select portions of a print task to be printed on selected mediums, hence meeting the limitation “enabling a selected portion of the print task to be printed without printing a non-selected portion of the print task”. Notably, the examiner did not assert that the print task is “information in the print-ready format”, but the examiner did assert that the printing system in Housel et al. has an ability to select portions of a print task to be printed.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

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1992). In this case, Mori teaches a printer driver that converts the print data into information in print-ready-format (Mori, column 3, lines 1-5), and Housel et al teaches a printing device that enables to select a portion of a print job (Housel et al., paragraphs 59-61). That is, Housel et al. does teach a printing device that enables to select a portion of a print job, and this portion does not need to be in print ready format that was already taught by Mori. Therefore, it would have been obvious to one having ordinary skill in the art to modify Mori to permit portions of the print ready information to be selected and printed since Housel et al. teaches that enabling a selected portion of a print job to be printed is beneficial for permitting a user to more easily designate their print jobs.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's argument with respect to claims 2-9 and 21-29 on page 13 has been traversed above.

Applicant's argument with respect to claim 10 on page 14 has been traversed above.

Applicant's argument with respect to claim 12-20 and 30 on page 14 has been traversed above.

Applicant's argument with respect to claim 31 on page 15 has been traversed above.

Applicant's argument with respect to claim 32 on page 15 has been traversed above.

For the above reasons, it is believed that the rejections should be sustained.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoai-An D. Nguyen whose telephone number is 571-272-2170. The examiner can normally be reached on M-F (8:00 - 5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le can be reached on 571-272-2233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoai-An D. Nguyen
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